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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,458	08/20/2001	Haralabos E. Gakidis	111259.120	5623

23483 7590 04/07/2005

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EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,458

Applicant(s)

GAKIDIS ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/4/02 was filed after the mailing date of the application on 8/20/01. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-17, 32-33 and 22-31, 34-36, drawn to a method and apparatus for an idea presentation and evaluation system that allows evaluation of ideas, classified in class 705, subclass 10.
 - II. Claims 19-21, drawn to a method, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, they have different modes of operation, see steps (a), (b), and (c) of claim 1 vs. (a), (b) and (c) of claim 19, especially the last step (c) of each claim which normally dictates the effects or demonstrates the result of the scope of the invention.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Mr. Michael Diener on 3/1/2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18, 22-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-18, 22-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-18 are directed to "A method implemented in a network and comprising", which is not within one of the classes of invention set forth in § 101.

The "method implemented in a network" comprising the steps of:

- (a) the network receiving ...;
- (b) the network including ...;
- (c) the system maintainingbased on the interactions", as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "method implemented in a network" comprising the steps of (a)-(c) as shown are:

- 1) merely an abstract idea and
 - 2) does not reduce to a practical application in the technological arts (integration with computer/computer network) and are therefore are found to be non-statutory.
- Merely reciting of "network" is insufficient since network merely means things or elements connected into a net.

See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Also, in the present case, claims 22-36 are directed to "An idea management system", with all the cited functions, which is not within one of the classes of invention set forth in § 101.

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The "idea management system" comprising the functions as claimed:

1) does not reduce to a practical application in the technological arts (integration with computer/computer network) and are therefore are found to be non-statutory.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-17, 32-33, 22-31, 34-36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for monitoring of interactions, does not reasonably provide enablement for evaluation of "idea share transaction". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to assess a value of the "idea share transaction" the invention commensurate in scope with these claims.

10. Claims 1-17, 32-33, 22-31, 34-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Pages 31-32, especially lines 6-19, parts (a) and (b) have been carefully reviewed, however, it's not clear how to assign a value to the "idea share transaction" since phrase like "idea may be valued as the sum of the equity fraction transacted multiplied by the estimated hourly wages of the "expert" Over all

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transactions” is not clear. Recitation of several working examples of how the values are derived are needed to clarify the issues and overcome the rejection.

11. Claims 1-17, 32-33, 22-31, 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 1, line 2, the phrase “the method” lacks antecedent basis. Also, (2) it’s not clear the relationship between the “system” on line 1 and the “network” on line 2. (3) line 3, the term “it” is confusing because it’s not clear what it refers to. (4) the last 2 lines “assessing a value, to each of the 1st group of evaluators based on the interaction” is vague and indefinite because it’s not clear whether the assessing a value is (a) to the 1st group or (b) to the “idea shares transaction” as mentioned above. From the specification, it appears that the invention deals with the evaluation of the “idea” and not the “to each of the 1st group of evaluators”. (5) Also, it’s not clear why the assessing of the value is to each of the 1st group of evaluators only and not including the 2nd group of evaluators.

12. Claim 4 is vague and indefinite because it depends on itself.

13. Claims 5, 7, 9, 10, 11, 12, 13, 14, 15, 16 and 18 are vague and indefinite because they are written in passive state which are vague and indefinite for a method claim. Conversion of the claim language to positive/active state is recommended to improve clarity and overcome the rejections.

14. In claim 14, line 3, the term “ideas to “proceed” to” is vague and indefinite.

Furthermore, citation of “ “ is not proper in the claim.

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15. Claim 18 recites the limitation "the contracts" and "the parties" in lines 1-2. There are insufficient antecedent basis for these limitations in the claim.

16. Apparatus claims 22-36 are vague and indefinite because they fail to recite structurally elements or structures. Apparatus claims should cover what a device is, not what a device does. See *Hewlett-Packard Co. vs. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The current claim set covers only the functions of the system.

In Apparatus claim 22, lines 3-5, the phrase "assigns values to: (1) the submitters of ideas, (2) the evaluators, and (3) the ideas themselves" is vague and indefinite because it's not clear whether the assessing a value is (a) to the groups or (b) to the "idea shares transaction" as mentioned above. From the specification, it appears that the invention deals with the evaluation of the "ideas" and not to the submitters and the evaluators. Also the pronoun term "themselves" is vague and indefinite since it's not clear what they refer to.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

18. Claims 22-36 are rejected under 35 U.S.C. 102(a) as being anticipated by FERGUSON or JACOBI et al.

As for independent apparatus claim 22, FERGUSON discloses an idea management system {see Fig. 2, 3}. As for the limitations of the functions of the system or what the system does, i.e. "receiving idea, assigns values", etc., these carry no patentable weight in an apparatus claim. Apparatus claims should cover what a device is or structures or structurally elements, not what a device does. See *Hewlett-Packard Co. vs. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

As for independent apparatus claim 22, JACOBI et al discloses an idea management system {see Fig. 1}. As for the limitations of the functions of the system or what the system does, i.e. "receiving idea, assigns values", etc., these carry no patentable weight in an apparatus claim. Apparatus claims should cover what a device is or structures or structurally elements, not what a device does. See *Hewlett-Packard Co. vs. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

As for dep. claims 23-36, which further deals with other functions of the system, they are rejected for the same reason set forth in claim 22 above.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. US Patent:

1) US Patent 6,064,980 by Jacobi et al. fairly teaches the collaborative filtering method for evaluating an idea.

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2) US Patent 5,995,951 by Ferguson fairly teaches a network collaboration method and apparatus for evaluating proposals from submitters through several rounds in order to obtain the best results. See Figs. 3, 4, 8A, 8B.

3) US 2001/0025259 by Rouchon is cited for further information on Garageband.com.

II. NPL:

1) "A model ...rural enterprise" is cited to teach a method for strategic planning and decision making with interaction and value making.

2) See www.garageband.com.

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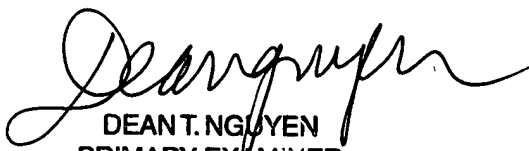
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053 or (571) 272-6806 (by April 15, 2005). My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
March 3, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER